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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,589

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Anne-Sophie Bessis

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09/21/2009

EDWARDS ANGELL PALMER & DODGE LLP

P.O. BOX 55874

BOSTON, MA 02205

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,589	Applicant(s) BEISS ET AL.	
	Examiner Taofiq A. Solola	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 33-43 is/are pending in the application.
- 4a) Of the above claim(s) 21-30, 33-40 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-30, 33-43 are pending in this application.

Claims 21-30, 33-40, 43 are non-elected.

Claims 31-32 are deleted.

Response to Restriction

The election, with traverse, of group I, claims 1-20, 41-42 in part, in the Paper filed 7/10/09, is hereby acknowledged. The traversal is on applicant's belief that multi groups can be searched and examined together without undue burden. This is not persuasive because applicant fails to set forth any basis for the argument. Also, the groups set forth in the last office action belong to different classes and subclasses. The Examiner is required to search all the classes and subclasses to determine patentability and such is deemed undue burden. Applicant also elects example 12, page 60, for search purpose. Claims 1-20, 41-42 are being examined in part according to applicant's election. In the last Office action all reference to B as $C(O)[C(O)C_0-C_2alkyl]$ should be $C(O)-C_{0-2}-alkyl$.

The restriction is still deemed proper and therefore made FINAL.

Status of Claims

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall into the same class and subclass as the elected compound, but may include additional compounds, which fall in related subclasses. Examination of the elected compound AND the entire scope of the invention encompassing the elected compound as defined by common classification results in the following:

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In formula I, A is 1,2,4-oxadiazole-5-yl; B is $-C(O)C_{0-2}$ -alkyl, $-C(O)C_{0-6}$ -alkenyl, $-C(O)C_{0-6}$ -alkynyl; P is optionally substituted phenyl; W is piperidin-1-yl; Q, R1 and R2 are as defined in claim 1. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claims 1-20, 41-42, are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-elected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20, 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“H” in claim 1, has several representations. It represents substituents other than “hydrogen” rendering the claims confusing and therefore indefinite. See claim 1, page 109, lines 5-6 and 13-15.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-20, 41-42 are rejected under 35 U.S.C. 102(a) as being anticipated by Arkin et al., US 20030149049 A.

Arkin et al., disclose compound 28, page 17; the last compound on page 19 and compounds 36, 38, 40 on page 20. Arkin et al., also disclose their compositions.

Claims 1-20, 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Chalquest, WO/01/054498 A.

Chalquest discloses figures 1-301 and their compositions.

Claims 1-20, 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Herbert et al., WO/00/025768 A.

Herbert et al., disclose compounds 4098, pp. 161; 4475, pp. 162; 8080, pp. 164; 4491 and 4613, pp. 165; 4478 and 2300, pp. 166; 8093, pp. 168, and their compositions.

Claims 1-20, 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al., US 3,991,064.

Brown et al., disclose compounds 5 and example 2, and their compositions. See col. 2.

Claims 1-20, 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Rigby et al., US 2002/00773377 A1.

Rigby et al., disclose compounds in Tables I-IV, pp. 17-55, and their compositions.

By amending the claims as set forth above under Status of Claims the rejections would be overcome.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-20, 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior arts listed above, individually.

Applicant claims compounds of formula I, their compositions and method of use for treating CNS disorders.

Determination of the scope and content of the prior art (MPEP 2141.01)

The prior arts disclose similar compounds, their composition and method of use for treating CNS disorders.

Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of the prior arts is that the alky chain in the compounds of Applicant is longer than in the prior arts. In other words, applicant replaced H with alky in the compounds of the prior arts. Also, applicant claims alkyl substituents instead of H by the prior arts and vice versa.

Finding of prima facie obviousness---rational and motivation (MPEP 2142.2413)

However, H and alkyl are art recognized equivalents. *In re Lincoln*, 126 USPQ 477, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

When the difference between compounds is the length of a carbon chain such are adjacent homologs. However, adjacent homologs are prima facie obvious. *In re Henze*, 85 USPQ 261 (1950). Therefore, the instant invention is prima facie obvious from the teaching of the prior arts. One of ordinary skill in the art would have known to replace H with alkyl or vice

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versa at the time the invention was made. The motivation is from knowing that H and alkyl are equivalents and that adjacent homologs would have similar biochemical properties.

Alternatively, given the teachings of the prior arts and well known knowledge in the art, it would have been obvious to try replacement of H with alkyl or vice versa at the time the invention was made.

When there is motivation

to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under [35 USC] 103.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct 1727,----, 82 USPQ2d 1385, 1397 (2007).

Alternatively, applicant has done nothing more than substitutes known equivalents in the prior arts' compounds. However, such substitution is obvious from the prior arts and knowledge in the art. "When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *United States v. Adams*, 383 U.S. 49, 50-51 (1966). Cited in *KSR Int. Co. v. Teleflex Inc.*, 550 U.S. ----, 82 USPQ2d 1385 (2007). The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR, supra*.

By amending the claims as set forth above under Status of Claims the rejections would be overcome.

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Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20, 41-42 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 11/667,096. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the compounds in US '096 are claimed in the instant the difference being the scope of the claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

By amending the claims as set forth above under Status of Claims the rejections would be overcome.

Objection

Claims 1-20, 41-42 are objected to for containing non-elected inventions. The compounds must be amended as set forth above under Status of Claims to place the application in condition for allowance.

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Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit 1625

September 18, 2009